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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,280

01/27/2005

Takako Araki

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23850 7590 05/14/2008  
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EXAMINER

NGUYEN, LINH THI

ART UNIT

PAPER NUMBER

2627

MAIL DATE

DELIVERY MODE

05/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/520,280	<b>Applicant(s)</b> ARAKI, TAKAKO	
	<b>Examiner</b> LINH T. NGUYEN	<b>Art Unit</b> 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/4/08 has been entered.

### ***Claim Objections***

Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend on any multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim 3/4 not been further treated on the merits.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7133344. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The patent claims include all of the limitations of the instant application claims, respectively. The patent claims also include additional limitations. Hence, the instant application claims are generic to the species of invention covered by the respective patent claims. As such, the instant application claims are anticipated by the patent claims and are therefore not patentably distinct therefrom. (See *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2D 1869, "a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim", *In re Goodman*, 29 USPQ2d 2010, "Thus, the generic invention is 'anticipated' by the species of the patented invention" and the instant "application claims are generic to species of invention covered by the patent claim, and since without terminal disclaimer, extant species claims preclude issuance of generic application claims").

Claims 1 and 3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No.

7106678. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The patent claims include all of the limitations of the instant application claims, respectively. The patent claims also include additional limitations. Hence, the instant application claims are generic to the species of invention covered by the respective patent claims. As such, the instant application claims are anticipated by the patent claims and are therefore not patentably distinct therefrom. (See *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2D 1869, "a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim", *In re Goodman*, 29 USPQ2d 2010, "Thus, the generic invention is 'anticipated' by the species of the patented invention" and the instant "application claims are generic to species of invention covered by the patent claim, and since without terminal disclaimer, extant species claims preclude issuance of generic application claims").

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being unpatentable by Nanba et al (US Patent number 5796704).

In regards to claim 1, Nanba et al discloses a disk playback device (Fig. 3A-B) capable of reproducing signals (Fig. 3A, element 68) from a disk by irradiating the disk with a laser beam from an optical head (Fig. 3A element 12), the disk playback device comprising a laser drive circuit (Fig. 3A, element 64) capable of feeding a drive signal to the optical head (Fig. 3A element 64 connected to element 12 of the laser diode 22) and adjusting a power of the laser beam irradiated (Fig. 3B, element 38) by the optical head and a control circuit for controlling operation of the laser drive circuit (Fig. 3A-B, element 38 is connected to 64 laser driving circuit), wherein the control circuit comprises reproduction power optimizing means (Fig. 3B, element 74) for repeatedly optimizing the power of the laser beam for signal reproduction (Column 7, lines 30-33), and the reproduction power optimizing means comprises: evaluation data detecting (activation control element) means for detecting evaluation data representing quality of a signal reproduction state (Fig. 3A, elements 20, 44, 56, and 68); retrieving means for retrieving one boundary value (Fig. 6, point 108) of two boundary values (Fig. 6, point 112) of a reproduction power wherein the evaluation data is a prescribed value or in the vicinity of the prescribed value (Fig. 5 and Fig. 6 and Column 9, line 31-Column 10, line 3); and optimum reproduction power calculating means (Fig. 4, element 85) for calculating an optimum reproduction power based on the one retrieved boundary value retrieved (based on  $\Delta W$  the boundary value would be retrieved according to Fig. 5 and Fig. 6), wherein the retrieving means retrieves a new boundary value based on a boundary value obtained by a previous optimizing processing and not based solely on current power reproduction level (Fig. 7, boundary value  $W_0$  is found by using the previous

optimum reproducing power found in step 8, which corresponds to different temperature changes of 0, 30, or 60 degree Celsius in step S4-S10, therefore, the different boundary would be at point 100, 98, or 96 shown on Fig. 5. Hence, the boundaries are retrieved by previous optimizing processing (Fig. 8, return) to step 4 on Fig. 7 to find a new boundary using the optimum reproducing power in step 8).

In regards to claim 2, Nanba et al discloses a disk playback device according to claim 1, wherein the retrieving means retrieves a lower boundary value having a smaller value from the two boundary values (Fig. 8, S4), and the optimum reproduction power calculating means adds a predetermined value to the lower boundary value to thereby determine the optimum reproduction power (Fig. 8, S5).

In regards to claims 1/3 and 2/3, Nanba et al discloses a disk playback device, wherein the evaluation data is a frequency of occurrence of bit errors included in a reproduced signal (Fig. 10).

In regards to claim 4, it's not treated on the merits, however, Applicant's attention is directed to Fig. 4 in the device of Nanba et al which discloses a disk playback device comprises temperature detecting means (Fig. 4, element 84) for detecting a temperature of the disk, and the reproduction power optimizing means optimizes the reproduction power whenever the temperature of the disk varies by a predetermined temperature (Fig. 7, S9-10).

### ***Response to Arguments***

Applicant's arguments filed 12/14/07 have been fully considered but they are not persuasive. Applicant argues that Namba does not disclose "wherein the retrieving means retrieves a new boundary value based solely on a boundary value obtained by a previous optimizing processing and not a current power reproduction level." However, Namba discloses new boundary value (Fig. 5, depending on the temperature boundary could be at point 100, 98, 96) based solely on a boundary value obtained by a previous optimizing processing (Fig. 7 and 8, the first boundary point is at 100 (Fig. 5) if the temperature is at 0 degree then the optimum reproducing is calculated in Fig. 8 and return back to Fig. 7 to find another boundary as time has elapsed in step 4 and the previous optimizing processing has occurred again to find the new boundary for another optimum reproducing power using the optimum reproducing found in step 8; Column 7, line 39 and Column 8, line 42).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINH T. NGUYEN whose telephone number is (571)272-5513. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NL/

/Thang V. Tran/  
Primary Examiner, Art Unit 2627